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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,997	06/28/2005	Cheol-Su Lee	J323-053 US	9049
21706 7590 08/29/2008 NOTARO AND MICHALOS 100 DUTCH HILL ROAD SUITE 110 ORANGEBURG, NY 10962-2100				
EXAMINER ANTONIENKO, DEBRA L				
ART UNIT 3689		PAPER NUMBER		
MAIL DATE 08/20/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/540,997

Applicant(s)

LEE, CHEOL-SU

Examiner

DEBRA ANTONIENKO

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to applicant's communication on 6/28/05, wherein claims 1-5 are currently pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant claims "indicating an identification code for goods of the big-name brand or genuine quality with an audio or visual tag, an RFID tag, etc." However, it is unclear as to what applicant is claiming. Is applicant claiming using either an audio or visual tag or RFID or etc., or is applicant claiming an audio or visual tag and a RFID and etc. Additionally, the term "etc." is vague and indefinite. Furthermore, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP 2173.05(d).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miettinen et al., International Publication Number WO 01/54346 A1 (hereinafter referred to as Miettinen) in view of Coppersmith et al. U.S. Patent Number 6,996,543 B1 (hereinafter referred to as Coppersmith).

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Regarding Claim 1, Miettinen teaches a method for servicing an electronic certificate indicating an identification code (page 4, lines 34-37; base identity, first electronic identity); requesting creation and transmission of an electronic certificate (page 5, lines 1-5; id response, second electronic identity, second certificate) by inputting the identification code (identifier) into an electronic certificate server (identity registration authority; page 9, lines 35-38; Certificate Authority CA server), said electronic certificate comprising the identification code, a character image (Figure 3), a management program (Figure 2); creating the electronic certificate after confirming the identification code (page 5, lines 8-13 and lines 24-27; digitally signs); transmitting the electronic certificate through a wire/wireless network (page 5, lines 16-21); and displaying the character image of the electronic certificate on a display apparatus (Figure 3).

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Miettinen does not explicitly disclose using an audio or visual tag, a RFID tag before the first distribution or the first purchase and checking it at the first distribution or the first purchase. Also, Miettinen does not explicitly disclose being constructed so that only one electronic certificate can be created per goods when being created and said one electronic certificate can only move after being created. However, Coppersmith discloses smart tags created by the manufacturer and then checked after purchase (column 3, lines 24-28; column 4, lines 23-39). Also, Coppersmith discloses generating a single serial number (column 4, lines 18-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Miettinen to include a tag in order to provide easy access to the certification information. Also, it would have been obvious to create only one serial number or certificate per product, otherwise multiple identification numbers would defeat the purpose. This is well known, for example, the VIN used for automobiles.

Regarding Claim 2, Coppersmith further teaches wherein a secret code may be provided together with the identification code, in which the secret code (routing information) is able to be first open and known at the first distribution or the first purchase and the secret code being inputted together with the identification code (serial number) for creating the electronic certificate (1), otherwise the secret code may be transmitted at the first distribution or the first purchase, the electronic certificate (1) comprising the secret code (column 5, lines 8-32; column 6, lines 1-14). It would have been obvious to one of ordinary skill in the art at the time of the invention to include

more than one piece of information in the certificate in order to make authentication more precise.

6. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miettinen in view of Coppersmith and further in view of Anderson, U.S. Patent Application Number 2005/0257055 A1 (hereinafter referred to as Anderson).

Regarding Claim 3, Miettinen further teaches wherein a database for the electronic certificate is constructed by the electronic-certificate creation server at the time of creation and transmission of the electronic certificate (page 5, lines 31-37; Figure 1; it is obvious to store data when created, otherwise it can not be used or transmitted again).

Miettinen and Coppersmith do not explicitly disclose said method further comprising the steps of transmitting results of the certification or authentication as for the electronic certificate and/or information when certification or authentication is requested from the client through the authentication/management server, and achieving a change in ownership of the goods of the big-name brand or genuine quality by moving the electronic certificate to the client of a transferee together with transfer of the goods and cancelling the electronic certificate from the client of a transferor. However, Anderson discloses the ownership record can be recreated at any time by the network from internal resources in order to transmit to the device for authentication ([0021]-[0023]; Figure 4). It would have been obvious to one of ordinary skill in the art at the time of the

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invention to provide the capabilities to change ownership in order to further guard against theft.

Regarding Claim 4, Miettinen, Coppersmith, and Anderson disclose the limitations of Claim 3 as discussed above. Coppersmith further discloses wherein the change in ownership of the goods is achieved by moving the electronic certificate from the client of the transferor to the client of the transferee through the authentication/management server (column 5, lines 47-59; it could be kept and maintained as a title and record of the whole resale history of the product). It would have been obvious to one of ordinary skill in the art at the time of the invention to keep track of ownership in order to further guard against theft.

Regarding Claim 5, Miettinen or Coppersmith do not explicitly disclose said method further comprising the steps of inducing a change in the secret code after the step of transmission of the electronic certificate (1), and changing the previously known secret code. However, Anderson discloses the ownership record and any generated device ID includes a value that changes over time ([0045]). It would have been obvious to one of ordinary skill in the art at the time of the invention to change a secret value with time or with new ownership in order to maintain the secrecy. This is well known, for example, changing passwords.

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Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kumagai et al., U.S. Patent Number 7,409,553 B2 discloses a method for a public key certificate generation and validation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBRA ANTONIENKO whose telephone number is (571)270-3601. The examiner can normally be reached on Monday through Thursday, 7:30 AM to 4:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DA

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689